

### REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 1 and 18 are amended and no claims are added or cancelled. Hence, Claims 1-3, 5-6, 8-10, 12-13, 18-21, and 25-34 are pending in the application.

#### **I. SUMMARY OF THE REJECTIONS/OBJECTIONS**

Claims 8-10, 12-13, 25-28, and 32-34 stand objected to under 37 CFR 1.75(c) as allegedly being of improper form for failing to further limit the subject matter of a previous claim. This objection is respectfully traversed.

Claims 1-3, 5-6, 18-21, and 29-31 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

Claims 1-3, 5-6, 8-10, 12-13, 18-21, and 25-34 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2004/0103024 to Dorab Patel et al. ("*Patel*"). This rejection is respectfully traversed.

#### **II. THE OBJECTION**

Claims 8-10, 12-13, 25-28, and 32-34 stand objected to under 37 CFR 1.75(c) as allegedly being of improper form for failing to further limit the subject matter of a previous claim.

Claims 8-10, 12-13, 25-28, and 32-34 further limit the subject matter of the claims on which they depend because the claims on which they depend cover both hard-wired and software-based implementations of the recited methods. Claims 8-10, 12-13, 25-28, and 32-34, on the other hand, limit coverage to only software-based implementations (i.e. implementations in which a processor reads and executes instructions from a computer-readable medium). Since Claims 8-10, 12-13, 25-28, and 32-34 cover only a subset of those implementations covered by

the claims on which they depend, they clearly further limit the subject matter of the claim on which they depend.

With respect to this objection, it is recognized that it is uncommon for a dependent claim to have a different form than the claim on which it depends. However, such a practice is explicitly authorized by the MPEP. In fact, many patents have issued with this exact form of dependent claim, including:

6,711,567 Delivering non-default items in association with search results  
 6,661,877 System and method for providing access to a unified message store logically storing computer telephony messages  
 6,647,510 Method and apparatus for making available data that was locked by a dead transaction before rolling back the entire dead transaction  
 6,633,891 Managing replacement of data in a cache on a node based on caches of other nodes  
 6,631,371 Database fine-grained access control  
 6,130,677 Interactive computer vision system  
 6,031,934 Computer vision system for subject characterization

In all of these cases, the USPTO ultimately found the claims to be in proper dependent form. However, due to the uncommon nature of such claims, it was necessary in at least one previous case to set forth a detailed explanation of the propriety of such claims. That argument is reproduced hereafter. It should be noted that the claim at issue in that prior case was a computer-readable medium Claim 7 which depended on an independent method Claim 1. Claims 8-10, 12-13, 25-28, and 32-34 have near identical form of Claim 7, so the explanation provided hereafter applies equally to the present Claims 8-10, 12-13, 25-28, and 32-34.

#### A. DETAILED EXPLANATION OF PROPRIETY OF CLAIM

Various tests have been established to determine whether a particular claim qualifies as a proper dependent claim. Significantly, none of the tests requires the dependent claim to fall within the same statutory class as the claim on which it depends. Specifically, MPEP § 608.01(n) states, among other things:

**“The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper.** Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.”

*1. Test #1: Claim 7 is proper under 35 U.S.C. § 112*

35 U.S.C. § 112 is the statutory section that sets forth the requirements of a proper dependent claim. In paragraph 4, 35 U.S.C. § 112 states:

Subject to the following paragraph, a claim in dependent form shall **contain a reference to a claim previously set forth** and then **specify a further limitation of the subject matter claimed.** A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The first sentence of this paragraph sets forth the two requirements for a proper dependent claim, and the second sentence sets forth the legal significance to the dependency.

With respect to the requirements, a proper dependent claim must (1) contain a reference to a claim previously set forth, and (2) specify a further limitation on the subject matter claimed. Both of these requirements are clearly satisfied by Claim 7. Specifically, Claim 7 clearly contains a reference to Claim 1. In addition, Claim 7 specifies the further limitation that instructions for performing the method of Claim 1 must be stored on a computer-readable medium, so that the method would be performed when one or more processors execute the instructions. Since Claim 1 does not itself require that the method be performed by executing stored instructions, the limitation added by Claim 7 qualifies as a further limitation.

Because Claim 7 is a proper dependent claim, the second sentence of 35 U.S.C. § 112, fourth paragraph indicates that it is to be construed to incorporate by reference all the limitations of the claim to which it refers. Thus, in the present case, Claim 7 is to be construed to incorporate all limitations of the method set forth in Claim 1. That interpretation of Claim 7

is consistent with Applicant's understanding of Claim 7. Specifically, to infringe Claim 7, a computer readable medium would have to include instructions for each and every step recited in the parent Claim 1.

2. *Test #2: Claim 7 is proper under 37 C.F.R. § 1.75(c)*

37 C.F.R. § 1.75(c) states:

"One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application...."

The test set forth in 37 C.F.R. § 1.75(c) is merely an abbreviated restatement of the test set forth 35 U.S.C. § 112, fourth paragraph. As explained above, Claim 7 refers back to Claim 1, and introduces limitations that are not present in Claim 1. Consequently, Claim 7 satisfies the 37 C.F.R. § 1.75(c) for the same reasons that it satisfies the 35 U.S.C. § 112, fourth paragraph test.

3. *Test #3: Claim 7 is proper under MPEP § 608.01(n)*

MPEP § 608.01(n) states:

"the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Unfortunately, the MPEP test involves a circular reasoning, and is therefore less useful than the tests set forth in the relevant statute and rules. Specifically, the MPEP test indicates that incorporation of all of the limitations of the base claim is what determines whether a claim is a dependent claim. However, the statute clearly dictates that, by virtue of a claim being dependent, the claim must be construed to incorporate all of the limitations of the base claim.

However, in spite of the difficulty posed by this circular reasoning, it is respectfully submitted that Claim 7 is also proper under the MPEP test. As mentioned above, it is fully intended that Claim 7 incorporate all of the limitations of Claim 1. In other words, to infringe

Claim 7, a computer readable medium must include instructions for performing each and every limitation recited in Claim 1.

To the extent that the three tests would yield different results, it is respectfully submitted that the outcome of the test set forth in the statute should govern. However, in the present case, it is respectfully submitted that all tests yield the same results; namely, that Claim 7 is a proper dependent claim. Thus, withdrawal of the 37 C.F.R. § 1.75(c) rejection is respectfully requested.

### III. THE REJECTION NOT BASED ON THE CITED ART

Claims 1-3, 5-6, 18-21, and 29-31 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Office Action asserts that the claims “are related to mental processes” (page 4). It is respectfully noted that Claim 1 is amended to recite an electronic content provider computer system performing various steps, such as receiving advertisements, storing revenue information, receiving a request from a client to provide electronic content over a network, etc. Therefore, because an electronic content provider computer system is performing these steps, the claims are not related to mental processes. Reconsideration and withdrawal of this rejection is respectfully requested.

### IV. THE REJECTION BASED ON THE CITED ART

Claims 1-3, 5-6, 8-10, 12-13, 18-21, and 25-34 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Patel*.

#### A. CLAIM 1

Claim 1 recites:

A method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising an electronic content provider computer system performing the steps of:

- receiving a plurality of advertisements from a plurality of advertisers;
- storing revenue information that indicates potential revenue amounts for the plurality of advertisements, wherein each of the plurality of advertisements is associated with corresponding delivery criteria;
- associating each of the plurality of advertisements with a priority class, wherein the priority class associated with each of the plurality of advertisements indicates whether the corresponding advertisement is the subject of a guaranteed contract;
- receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement; and**
- in response to receiving the request, the electronic content provider computer system performing the steps of:**
  - comparing slot attributes of the slot with the delivery criteria of the plurality of advertisements to determine a subset of the plurality of advertisements that qualify for inclusion in the slot,**
  - wherein the slot attributes of the slot include at least one of (a) the nature of the piece of electronic content, (b) the size of the slot within the piece of electronic content, or (c) the placement of the slot within the piece of electronic content;
  - filtering, out of the subset of the plurality of advertisements, advertisements that have a priority class that is lower than the priority class of any other advertisement that belongs to the subset;**
  - selecting an advertisement from the subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts. (emphasis added)**

#### 1. Overview of Patel

One of the major deficiencies in *Patel* is that *Patel* mentions almost nothing about how an advertisement is selected in response to a client request for electronic content. Instead, *Patel* is primarily concerned with providing a transactional exchange where advertisers can submit offers and publishers can choose which offers to accept resulting in a contract between an advertiser and a publisher. Therefore, much of *Patel*'s disclosure is concerning pre-contract formation, whereas most of the steps of Claim 1 are performed primarily after contract formation.

The closest that *Patel* comes to teaching that multiple advertisements may qualify for a particular slot in electronic content is the following statement regarding “rotating” banners: “To make advertising more effective, the banner for a particular page usually rotates. This means that one of many different ads may appear each time the web page is viewed” (paragraph 11). Thus, it appears that advertisements for a particular slot are selected in a simple round robin manner, regardless of (1) the slot attributes of the particular slot, (2) the priority class of the advertisements, and (3) the potential revenue amounts of each advertisement. Therefore, *Patel* fails to teach or suggest numerous features of Claim 1.

The Office Action cites paragraphs 7, 8, 153, 694, 696, and 697 of *Patel* for allegedly disclosing “receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement.” Paragraph 8 is the most pertinent paragraph and teaches that a consumer visits a site to view content and may be attracted to an advertisement, which the consumer can select. However, there are no details in these or other cited portions of *Patel* regarding how the advertisement is determined by the content provider.

2. *Patel fails to teach or suggest the comparing step and the slot attributes*

The Office Action cites paragraphs 7, 18, 23, 36, 138, 179, and 206 of *Patel* for allegedly disclosing the step of comparing slot attributes of a slot (in a piece of electronic content) with the delivery criteria of the plurality of advertisements and the recited slot attributes. Paragraph 18 states that, under the CPM model, publishers need to estimate how much of their available inventory matches an advertiser’s specifications so that the publishers know how much to sell, which estimation is not easy. *Patel* then teaches about the CPA model and the inverted CPA model. Paragraph 18 is thus related to the considerations a publisher

needs to take into account before the publisher offers advertising space (to advertisers) on the publisher's website.

Paragraph 23 and 24 correspond to two steps in the CPM model and teaches that (a) after an advertising deal is consummated, the advertising space is used as contracted and (b) after the advertisements appear, the advertiser pays for the delivery. Again, nothing in these paragraphs teaches how an advertisement is selected from a plurality of advertisements. Presumably, a publisher has one or more advertising spaces and only one advertisement is assigned to each advertising space.

Paragraph 36 is also only about pre-contract formation. Paragraph 36 introduces the inverted CPA model (on which the remainder of *Patel* is based) and states that, under this model, "publishers are not concerned about the particular advertisements that are placed on their site, as long as they do not contain objectionable material." All this means is that publishers will not accept contract offers from advertisers whose advertisements are objectionable to the publishers. This paragraph mentions nothing about how a publisher selects an advertisement (from a plurality of advertisement) to include in a slot in requested content once the publisher accepts offers from advertisers.

Paragraphs 138 and 206 are also about forming contracts with advertisers.

Paragraphs 179 and 180 discuss a problem with "rotating" banners, which problem includes determining what mechanism to use in sending a rotating banner to a browser to enable the user to select an advertisement and, as a result of the selection, be directed to the corresponding advertiser's website. Again, these paragraphs have nothing to do with comparing slot attributes of a slot with delivery criteria of advertisements.



3. *Patel fails to teach or suggest the filtering step*

The Office Action cites paragraphs 96, 131, 206, and 208 of *Patel* for allegedly disclosing “filtering, out of the subset of the plurality of advertisements, advertisements that have a priority class that is lower than the priority class of any other advertisement that belongs to the subset” as recited in Claim 1. This is incorrect. Paragraph 96 describes the function of application servers in *Patel*’s system, which function includes providing automation to have a dynamic real-time negotiation system, which further includes filtering and matching offers from advertisers to publishers. Although this paragraph uses the word “filtering” that is used in Claim 1, the “filtering” of *Patel* is much different. Specifically, instead of filtering advertisements from a plurality of advertisements that were selecting in response to a client request for content, as required in Claim 1, the filtering in paragraph 96 is regarding filtering offers for an advertisement contract. Like other cited paragraphs, this paragraph is directed to pre-contract formation and is, thus, completely unrelated to filtering advertisements in response to receiving a request for content.

Paragraphs 131, 206, and 208 are similar to paragraph 96 in that they use the term “filter” and/or “filtering” and that their use of the term “filtering” is regarding filtering advertisers’ offers, not advertisements in response to receiving a client request for content.

4. *Patel fails to teach or suggest the selecting step*

The Office Action cites paragraphs 231 and 523-525 of *Patel* for allegedly disclosing “selecting an advertisement from the subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts” as recited in Claim 1. This is incorrect. Paragraph 231 merely teaches that the Exchange module in *Patel*’s exchange system supports manual or automatic matching of offers and bids. The Exchange module can automatically alert a publisher if it detects a match.

Paragraphs 523-525 state, in their entirety:

- [0523] **Bids** may be sorted by the following user-definable criteria:
- [0524] Ascending/descending date of last modification
- [0525] Ascending/descending number of acceptances driven by the bid  
(emphasis added)

Again, these paragraphs are concerned with pre-contract formation activities, i.e., sorting bids from publishers. Therefore, these paragraphs cannot teach or suggest that, (1) in response to receiving a client request, (2) an advertisement is selected, (3) from a subset of advertisements, (4) based on potential revenue amounts.

Based on the foregoing, because *Patel* fails to teach or suggest all the features of Claim 1, Claim 1 is patentable over *Patel*. Reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 102(e) is therefore respectfully requested.

#### B. CLAIM 18

Claim 18 recites some of the features of Claim 1 discussed above that render Claim 1 patentable over *Patel*. For example, Claim 18 recites comparing, in response to request for content, slot attributes of a slot with delivery criteria of a plurality of advertisements to determine a subset of advertisements that qualify for inclusion in the slot. As another example, Claim 18 recites that an advertisement is selected from that subset based on whether the slot is reserved for buyers that satisfy a set of criteria. Therefore, Claim 18 is also patentable over *Patel*. Reconsideration and withdrawal of the rejection of Claim 18 under 35 U.S.C. § 102(e) is therefore respectfully requested.

#### C. CLAIMS 2, 3, 5, 6, 19-21, AND 29-31

Claims 2, 3, 5, 6, 19-21, and 29-31 are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of Claims 2, 3, 5, 6, 19-21,

and 29-31 is therefore patentable over *Patel* for at least the same reasons given above for the claim on which it depends. In addition, Claims 2, 3, 5, 6, 19-21, and 29-31 introduces one or more additional limitations. However, due to the fundamental differences already identified and to expedite the positive resolution of this case a separate discussion of all those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D. CLAIMS 8-10, 12, 13, 25-28 AND 32-34

Claims 8-10, 12, 13, 25-28 and 32-34 are computer-readable storage medium claims, each of which depends on one of the claims discussed above. Each of Claims 8-10, 12, 13, 25-28 and 32-34 is therefore patentable over the cited art for at least the same reasons given above for the claim on which it depends.

**V. CONCLUSION**

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,  
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